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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,442	11/24/2003	David S. Soane	CSMT-002PN	7123

23979 7590 09/14/2006

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EXAMINER

DODSON, SHELLEY A

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 09/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/721,442

Applicant(s)

SOANE ET AL.

Examiner

SHELLEY A. DODSON

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

SHELLEY A. DODSON
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 11/03; 9/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

1.

Claims 1-22 are pending in this application filed November 24, 2003.

Applicant's claims are directed toward colored sunscreen compositions.

Claim Rejections - 35 USC § 102

2.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3.

Claims 1-13 and 15-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Soane et al. WO 01/78663 A2 (R1).

Soane et al disclose preparations comprising nanostructures of polymeric materials which further comprise dyes or pigments. On page 4, R1 further discloses that said nanoparticles are comprise a polymeric shell entrapped with pigments, specifically titanium oxide or zinc oxide. Columns 4-7 specifically disclose the same polymers claimed by applicant in the instant case. Additionally in column 7, the reference discloses that the nanoscopic carriers may also be employed in UV absorbers/blockers. Page 4 discloses that the polymers further contain silicone. It is the examiner's position that the upper and lower CST are functional characteristics of the polymer and would be inherently exhibited by the polymers of the prior art although it is not stated because said polymers are incorporated by reference in applicant's instant specification.

Claim Rejections - 35 USC § 103

4.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5.

Claims 14 and 22 rejected under 35 U.S.C. 103(a) as being unpatentable over Soane et al. WO 01/78663 A2 (R1) in view of Pawelek et al. USP No. 5,384,116. (R2)

Soane et al disclose preparations comprising nanostructures of polymeric materials which further comprise dyes or pigments. On page 4, R1 further discloses that said nanoparticles are comprise a polymeric shell entrapped with pigments, specifically titanium oxide or zinc oxide. Columns 4-7 specifically disclose the same polymers claimed by applicant in the instant case. Additionally in column 7, the reference discloses that the nanoscopic carriers may

also be employed in UV absorbers/blockers. Page 4 discloses that the polymers further contain silicone. It is the examiner's position that the upper and lower CST are functional characteristics of the polymer and would be inherently exhibited by the polymers of the prior art although it is not stated because said polymers are incorporated by reference in applicant's instant specification. Soane et al disclose each and every aspect of the invention as claimed by applicant in the instant invention with the exception of specifically identifying the coloring agent as melanin as well as stating that the composition is employed in a method of treating the skin to provide retention of sunblock and coloring agents on the skin.

Pawelek et al disclose synthetic melanin as a sunscreen and tanning agent. Pawelek further discloses that melanin is useful for providing a naturally-appearing tan to mammalian skin and hair while still protecting the skin against ultraviolet damage.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the specific coloring agent of melanin as well as the method of providing UV protection and a tanning agent to mammalian skin of Pawelek into the composition and method of Soane in view of the teaching of Pawelek that melanin is useful for providing a natural

appearing color to the skin as well as the teaching of Soane that the polymeric nanostructures may contain additional coloring agents to include melanin.

Information Disclosure Statement

6.

The information disclosure statements (IDS) submitted were noted and the submissions are in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner has considered the information disclosure statements and made them of record.

Telephone Inquiries

7.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelley A. Dodson whose telephone number is (571) 272-0612 and fax number (571) 273-0612. The examiner can normally be reached on Monday-Thursday from 7:30 a.m. to 5:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached at (571) 272-0646.

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The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. This new location should be used in all instances when faxing any correspondence numbers to Group 1600. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Shelley A. Dodson
Primary Examiner
Art Unit 1616

September 11, 2006